LIBRARY
SUPREME COURT, U.S.

Office - Supreme Court, U. S.
FILED
OCT 17 1950
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1950

No. 32

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,

Petitioner,

v.

SUPERMARKET EQUIPMENT CORPORATION, substituted for EVELYN B. BRADLEY and JOE WEINGARTEN,

Respondent.

REPLY BRIEF ON BEHALF OF PETITIONER

JOHN H. GLACCUM,
Attorney for Petitioner,
Business Address,
24 West 40th Street,
New York 18, N. Y.

MUNN, LIDDY & GLACCUM,
EDWIN J. BALLUFF,
Of Counsel.

INDEX

	PAGE
General Statement	1
Reply to Respondent's Point I	2
Reply to Respondent's Point II	3
Reply to Respondent's Point III	3
Reply to Respondent's Point IV	3
Reply to Respondent's Point V	5
Reply to Respondent's Point IX	5

Table of Cases Cited

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation, 294 U. S. 477; 79 L. Ed. 1005	3
Enterprise Railway Equipment Co. v. Pullman Standard Car Mfg. Co., 95 F. 2d 17, 21	5
France Mfg. Co. v. Jefferson Electric Co., 106 F. 2d 605	5
McCarty v. Railroad Co., 160 U. S. 110, 116; 40 L. Ed. 358, 361	3
Sola Electric Company v. Jefferson Electric Company, 317 U. S. 173; 87 L. Ed. 165	6

Statutes Cited

37 U. S. P. Q. 643	5

Supreme Court of the United States

OCTOBER TERM, 1950

No. 32

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,

Petitioner,

v.

SUPERMARKET EQUIPMENT CORPORATION, substituted for EVELYN B. BRADLEY and JOE WEINGARTEN,

Respondent.

REPLY BRIEF ON BEHALF OF PETITIONER

Petitioner does not wish to comment at length on Respondent's statement of the case except to point out that Respondent's statement to the effect that it is engaged in licensing inventions of the Turnham and Bradley patents is based upon a reference to the Record which merely shows an unsuccessful attempt to license Petitioner (292) and a single license issued on February 7, 1947 to the Smith's Market Baskets, Inc., an operator of four stores in Jackson, Michigan, almost ten years after Weingarten began to use Turnham's construction and well over a year after the complaint in this action was filed.

Mention has been made in Respondent's brief of Petitioner's stipulation that the claims of the Turnham patent, if valid, were infringed by Petitioner's structure. At the opening of the trial Petitioner was asked to stipulate that claims 4, 5 and 6 of the Turnham patent, if valid, were

infringed. It was Petitioner's position that all of the claims, if valid, were infringed. While the trial court read from Respondent's trial memorandum (6) the stipulation is not in evidence. The only pertinent discussion relative to the attempted withdrawal of claims 1, 2 and 3 appears on pages 186 and 187 after counsel had brought out on cross examination of Respondent's expert that claims 1, 2 and 3 were obviously invalid (180-185).

In support of its argument of commercial success and Turnham's alleged solution of a long standing problem, Respondent refers to publications in trade magazines and in the publication "Domestic Commerce". The trade magazine, appearing at page 286A, was the January 1942 issue of a magazine entitled "Super Market Merchandising" put out by the Super Market Institute of which Mr. Weingarten was at one time president (87). In no way does it refer to the Turnham device, but on page 286B a device similar to that in suit is shown with the notation "Sketches and Photographs Illustrating This Article Courtesy The National Cash Register Company". Similarly, the article appearing at 280A (Plaintiff's Exhibit 3) refers to an article published in Super Market Merchandising, March 1947 issue, a month before this suit was tried. The issue of "Domestic Commerce" (226C) was published in March 1947 and states, "Retailer C—was a successful grocer in a suburban community in an Eastern city of about one million people". None of these items refer to Turnham who was employed by Weingarten in Houston, Texas.

Respondent's Point I to the Effect that the Elements of the Combination found by the Courts Below to be New are Set Forth in Claims 4, 5 and 6.

Contrary to the statement appearing in Respondent's brief, this point was the first one argued by Petitioner before the Circuit Court of Appeals. Respondent attempts

to traverse this point by attempting to apply general and indefinite terms instead of specific meanings."

It is submitted that the Respondent has failed completely to distinguish the cases of *McCarty* v. *Railroad Co.* (160 U. S. 110, 116; 40 L. Ed. 358, 361); *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corporation* (294 U. S. 477; 79 L. Ed. 1005) cited in Petitioner's principal brief on pages 12 and 13.

Respondent's Point II to the Effect that "Petitioner's Belated Contention that the Claims * * * do not Comply with R. S. 4888 is an Act of Desperation.

Under this point Respondent would have the Court believe that Petitioner had never raised this point before. However, an examination of the District Court's opinion appearing at 518 of the Record shows that the question was raised there, although the District Court was obviously in error in stating at page 519 "The essential structures, the extension and the bottomless self-unloading frame, are described as such and functional language is not being used 'at the exact point of novelty' ".

Respondent's Point III.

Petitioner has no comments relative to this point except to say that the Record shows that innumerable improvements have been made over the years by the super market operators to improve their service and that these various steps do not rise to the dignity of invention.

Respondent's Point IV. The Ray-O-Vac Case Supports Respondent's Position.

Respondent's attempt to compare the Ray-O-Vac case (*Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Company*) is

based on several untenable propositions. In the first place the claims of the Anthony patent were specific and directed to the exact invention. The Ray-O-Vac, or Anthony, patent settled a long standing problem, while the most that can be said of Turnham is that it mitigated a problem. As to the duration of the problem it suffices to say that even after the installation of the Turnham device in the Weingarten stores it was necessary to double the number of check out counters (96). It has been previously pointed out that the Turnham patent secured no commercial success, but, on the other hand, was universally disregarded as an invention. The alleged government indorsement, which was the article in the publication "Domestic Commerce", was not of Turnham's construction but of a device used by a stranger.

It has been pointed out previously that where the Court of Appeals does not pass on the separate claims in issue but finds invention in a combination of elements not embraced in any single claim, the case presents no question of concurrent findings by the courts below that the claims in issue involve invention. In *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corporation* (294 U. S. 477; 79 L. Ed. 1005) at page 480 of the U. S. Reports, the Court stated:

> "While both courts below have found invention and sustained the patent, the Court of Appeals, as will presently appear in more detail, did not pass on the separate claims in issue, but found invention in a combination of elements not embraced in any single claim. In consequence, the case presents no question of concurrent findings by the courts below that the claims in issue severally involve invention, see Concrete Appliances Co. v. Gomery, 269 U. S. 177, 180, 70 L. ed. 222, 224, 46 S. Ct. 42."

Respondent's Point V. State of Art Prior to Turnham.

Both the courts below found that the elements set forth in Turnham's claims were old with the exception of the extension to the check out counter, which is referred to only in claim 1. It is submitted that even assuming *arguendo* that a direct anticipation is not shown, certainly the state of the art is sufficient to negative any invention on Turnham's part. (See *Enterprise Railway Equipment Co.* v. *Pullman Standard Car Mfg. Co.*, 95 F. 2d 17, 21.)

Respondent's Points VI, VII and VIII are pure argument and require no comment here.

Respondent's Point IX to the Effect that there was no Error in Allowing Respondent to Withdraw the Broader Claims 1, 2 and 3.

The Respondent here brought suit on the entire Turnham patent without limiting the action to any specified claims. At the trial it withdrew over Petitioner's strenuous objection, the broader claims of the patent. In its brief ~~Petitioner~~ Respondent cites the case of *France Mfg. Co.* v. *Jefferson Electric Co.* (106 Fed. 2d 605) and more particularly the language appearing at page 611 wherein the Court of Appeals refers to the refusal of the District Court to pass on claims of the patent before them, which claims were not declared and which were not in suit. The opinion of the Circuit Court of Appeals is indefinite as to what claims were before the Court, but a reading of the District Court's opinion (37 U. S. P. Q. 643) makes it clear that the plaintiff in the case cited never charged infringement of any other claims than 8, 14, and 19 and there was no question of withdrawal of claims from suit.

It is interesting to note that the failure of the Court to pass on the claims in *France* v. *Jefferson* resulted in the

Sola Electric case (*Sola Electric Company* v. *Jefferson Electric Company*, 317 U. S. 173; 87 L. Ed. 165) in which the other claims were held invalid.

CONCLUSION

It is submitted that respondent has failed to refute petitioner's argument and that the Court of Appeals and the District Court should be reversed and the cause remanded for dismissal of the complaint.

Respectfully submitted,

JOHN H. GLACCUM,
Attorney for Petitioner.

MUNN, LIDDY & GLACCUM,
EDWIN J. BALLUFF,
Of Counsel.